

DONALD R. ANTONELLI  
MELVIN KRAUS  
WILLIAM I. SOLOMON\*  
GREGORY E. MONTONE  
RONALD J. SHORE  
DONALD E. STOUT  
ALAN E. SCHAVELLI  
CARL I. BRUNDIDGE\*  
PAUL J. SKWIERAWSKI\*  
HUNG H. BUI\*  
ALFRED A. STADNICKI\*  
FREDERICK D. BAILEY  
\*ADMITTED OTHER THAN VA

LAW OFFICES  
**ANTONELLI, TERRY, STOUT & KRAUS, LLP**

SUITE 1800  
1300 NORTH SEVENTEENTH STREET  
ARLINGTON, VIRGINIA 22209

TELEPHONE (703) 312-6600  
FACSIMILE (703) 312-6666  
email@antonelli.com

OF COUNSEL  
DAVID T. TERRY  
HAROLD A. WILLIAMSON\*  
—  
RALPH T. WEBB\*  
STERLING W. CHANDLER\*  
—  
PATENT AGENT  
LARRY N. ANAGNOS

VIA FACSIMILE - 06 PAGES (Including This Cover)

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MAR 26 2004

OFFICIAL

RE: MAKI *et al.*, US Appl'n No. 09/900,144  
Att'y Docket 500.34077CC3  
Examiner E.M. Mercader - AU 3737 - USPTO Conf. No. 6500

**SUBMISSION OF STATEMENT OF SUBSTANCE AND §181 PETITION**

Sir:

Applicant hereby transmits the attached "Statement Of Substance And Petition Under 37 CFR §1.181" (5 pages) for entry in the USPTO file in the above-identified application.

**CERTIFICATE OF TRANSMISSION:**

I hereby certify that the attached "Statement Of Substance And Petition Under 37 CFR §1.181" (5 pages) is being **FORMALLY TRANSMITTED** via the USPTO CENTRAL FAX NO. 703-872-9306 on 26 March 2004.

  
Patricia J. Jaquett

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500.34077CC3/E2063-04EN

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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MAR 26 2004

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Applicant : Atsushi MAKI *et al.*  
Serial No. : 09/900,144  
Filed : 9 July 2000  
For : OPTICAL SYSTEM FOR MEASURING  
METABOLISM IN A BODY AND IMAGING METHOD  
Art Unit : 3737  
Examiner : E.M. Mercader  
Conf. No. : 6500

**STATEMENT OF SUBSTANCE AND PETITION UNDER 37 CFR §1.181**

Commissioner for Patents  
POB 1450  
Alexandria, Virginia 22313-1450

26 March 2004

Sir:

**STATEMENT OF SUBSTANCE**

In response to the Office Action having a USPTO mailing date of 24 November 2003 in connection with the above-identified application, Applicant submitted a Response on 24 February 2004. An Examiner's Interview Summary Record was mailed on 27 February 2004 for a teleconference held with the Examiner on 24 February 2004. Although the 24 February 2004 Response included a brief statement regarding the 24 February 2004 teleconference with the Examiner, it did not include a formal Statement of Substance in response to the 27 February 2004 Examiner Interview Summary Record. Applicant respectfully submits the following comments as required by 37 CFR §1.133(b).

In an attempt to obtain correction of defects and insufficiencies in the Office Action mailed 24 November 2003, in accordance with MPEP §710.06, Applicant

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timely filed a formal "Request For Corrected Office Action And Restart Of The Period For Response" in the USPTO on 18 December 2003 *via* completed facsimile transmission to the USPTO Central Facsimile Number. The Request is incorporated herein by reference in its entirety.

More than two months after filing the Request, Applicant still had not received a corrected or supplemental Action, or any other response, and therefore, an inquiry as to the status of the 18 December 2003 Request was left on the Examiner's voice mail on 24 February 2004. The Examiner promptly returned the contact the same morning, for which the Examiner was thanked. The Examiner indicated that the Request had been entered in the PALM docket system but had not yet been delivered to her, and stated that she would contact Applicant after she had reviewed the Request. The Examiner again contacted Applicant later the same morning, and during the second teleconference, highlights of the grounds for correcting the Office Action and restarting the period for response which had been given in detail in the Request were noted. The Examiner indicated that, in her opinion, none of the reasons given in the Request were valid grounds to correct the Action or restart the period for response, and such a corrected Action would not be forthcoming.

#### REBUTTAL OF INTERVIEW SUMMARY STATEMENTS

In the Examiner Interview Summary, the Examiner states, "[t]he Applicant argued that a new re-start period should be granted because the pre-amendment was not entered in full, cancelling claims 1-27." However, Applicant respectfully points out that the fact that the Preliminary Amendment filed 9 July 2001 was not entered in full was only one of the highlights of the grounds in the Request which

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was noted during the teleconference, as the remaining comments in the Interview Summary also indicate.

In the Examiner's Interview Summary, the Examiner states, "[j]ust because the Applicant disagrees with the rejection that does not make the non-final action defective." However, Applicant respectfully disagrees, since the Action is contentious because of its defects and insufficiencies, which is why Applicant requested a corrected Action. In response to the 23 November 2003 Action, it was necessary for Applicant to request an explanation of any grounds upon which rejections are based in order to determine their validity and respond accordingly, and to request withdrawal of the rejections for which double patenting is improper under both 35 USC §121 and 35 USC §119. Therefore, the Action contains such defects as to render it incapable of advancing prosecution of the application. Furthermore, Applicant respectfully directs attention to MPEP §710.06, which states in relevant part *verbatim*, "[w]here the citation of a reference is incorrect or an Office action contains some other defect and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant" (emphasis added). Another relevant part of MPEP §710.06 states *verbatim*, "[a] supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs" (emphasis added). Therefore, Applicant respectfully submits that MPEP §710.06 does not discriminate regarding type or degree of error, but instead, sets forth the USPTO policy of correction of any defect in prosecution, whether based on informalities

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or statutory grounds. In view of the above, Applicant respectfully submits that the defects listed in the 18 December 2003 Request are valid in accordance with MPEP §710.06.

In the Examiner's Interview Summary, with regard to the noted deficiencies in the grounds for rejection of the claims upon which any of the alleged double patenting rejections may be based, the Examiner states, "these are of the obviousness-type without another reference which means that the claims are anticipated and hence no obviousness explanation is required." Applicant respectfully disagrees, and directs attention to MPEP §804(B)(1), which relevant portions were iterated in the Request to support the validity of the request for correction of the 24 November 2003 Action. However, Applicant reiterates herein, in rebuttal of the Examiner's above statement, in relevant part *verbatim*, "in obviousness-type double patenting rejection should make clear: (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent" (underline and bold emphasis added). In view of the above, Applicant respectfully submits that explanation is most certainly required in accordance with MPEP §804(B)(1), and the defects listed in the 18 December 2003 Request are valid.

#### PETITION UNDER 37 CFR §1.181

In view of the continuance of the defective 24 November 2003 Office Action, the improper denial of the 18 December 2003 Request, and all of the above,

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Applicant respectfully petitions the Commissioner under 37 CFR §1.181, to vacate the 23 November Office Action, and to immediately mail either a new, non-final Action with valid grounds of rejection of the claims of record, or immediately issue a Notice of Allowance.

Respectfully submitted,



Paul J. Skwierawski  
Registration No. 32,173  
ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 North Seventeenth Street, Suite 1800  
Arlington, Virginia 22209-3801, USA  
Telephone 703-312-6600  
Facsimile 703-312-6666